

REMARKS/ARGUMENTS

Claims 1-26 are currently pending and have been examined.

Applicant has updated the status of the prior application referred to in the first paragraph of the disclosure. The drawings stand objected to because they do not show the handle comprised of rubber or an elastomeric material. There are no sectional views of the handle in any of the figures. The surface of rubber or any elastomeric material is shown in patent drawings without any markings or special representation. Sponge rubber in section is shown as alternating light and dark parallel stripes. However, the handle is shown in all of the figures in either a perspective or elevation view. It is respectfully requested that the objection to the drawings be withdrawn.

Claims 1-26 stand provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-40 of copending application 10/608,290. The apparatus covered by pending claims 1-26 in the present application is shown in FIGS. 10, 11 and 12 as an adjustable pipe repair clamp installation tool which is the reverse of that recited in claims 1-40 of the aforementioned copending application. The apparatus claimed in the aforementioned copending application is illustrated in FIGS. 10-16 in the copending application, which figures are attached hereto as Exhibits A-D for comparison. These drawings are labeled at the top as being of client's Case No. 10-CIP which is a continuation-in-part application of Serial No. 10/393,820, which is the parent of both Case No. 10-CIP and the present application. In pending claim 1, the clasp 168 is recited as coupled to the body portion 152 of the apparatus adjacent a first end thereof. This connection is accomplished by means of a first pivot/coupling pin 166 as shown in the

figures. Pending claim 1 further recites that the clasp 168 is adapted to engage an outer edge of one of the pipe repair clamp's flanges. Claim 1 also recites that a first end 164a of an arm 164 is pivotally coupled to the body portion 152 of the apparatus at a location intermediate first and second opposed ends of the body portion. Claim 1 further recites that a second opposed end 164c of arm 164 is adapted for insertion in an aperture in a first edge flange of a pipe repair clamp.

In the claims of the copending application, the clasp 112 which is adapted for engagement with an edge of a repair clamp flange is recited as pivotally coupled to the body portion 102 intermediate the first and second opposed ends thereof, and not adjacent a first end thereof as shown in FIGS. 10-16 in the copending application. The arm 110 in the copending application is claimed as having a first end pivotally coupled to the body portion adjacent a first end thereof, and a second opposed end adapted for insertion in an aperture in an edge flange of the repair clamp. See attached Exhibits A-D. Thus, while the arm and clasp recited in the two sets of claims describe the arm as adapted for insertion in an aperture in a repair clamp's first edge flange and the clasp as adapted for engaging an outer edge of the repair clamp's other edge flange, the recited positioning on and attachment of the arm and clasp to the body portion of the repair clamp installation apparatus is reversed in these two sets of claims. These two applications with different sets of claims were filed to secure claim coverage for the embodiment of the invention shown in FIGS. 10-12 of the subject application and the alternative embodiment shown in FIGS. 10-16 of the copending application cited by the Examiner in the double patenting rejection. Another way to look at these differences between these two embodiments of

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Applicant's invention is that the arm 164 in the present application includes a hook end 164c adapted for insertion in an aperture in an edge flange of a repair clamp, while the claimed arm 112 in the copending application includes an end 112a adapted for engaging an outer edge of an edge flange of the repair clamp, with both arms attached to the body portion of the apparatus at a location between its two opposed ends. In addition, the claimed clasp 168 in the present invention includes a clamp end 168a adapted for engaging an outer edge of a repair clamp edge flange, while the clasp 110 in the copending application includes a clamp end 110a adapted for insertion in an aperture in an edge flange of the repair clamp. Thus, the two claimed attachment mechanisms for engaging the repair clamp's flanges and the arm and the clasp to which these attachment members are connected are reversed in these two embodiments. The two embodiments of Applicant's invention disclosed and claimed in the present application and in the referenced copending application each have their own respective unique advantages when used in the confined spaces typically encountered in installing a repair clamp on a pipe which is frequently underground.

Claims 1-26 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 1,885,128 to Montgomery. Montgomery is directed to a load binder "for use in binding pipes, poles, lumber and other heavy articles on trucks, wagons and other vehicles, and for use in lifting extremely heavy loads." See page 1, lines 2-5. The load binder includes first and second hooks 18 and 33 disposed on opposed ends thereof and adapted to engage a chain such as of the link type. The primary object of the Montgomery load binder is to allow for adjustment of the binder after the combination of the binder and a flexible member, such as the link chain shown in the

figures, is positioned about the articles or objects being bound and prior to the tightening operation. This ability to adjust the binder about the load prior to tightening allegedly allows for compensation for excess strain when the binder is being adjusted as well as for accurate adjustment of the binder to prevent relative movement of the articles or objects being bound. See page 1, lines 6-18.

The Examiner states that "Montgomery discloses an apparatus for installing a repair clamp on a pipe, the repair clamp including a generally cylindrical body having first and second opposed edge flanges, a slot extending the length thereof for receiving the pipe and positioning the repair clamp about an outer circumference of the pipe, and plural nut and bolt combinations coupled to the edge flanges for drawing the repair clamp tightly about the pipe." Montgomery discloses none of this claimed structure. The load binder of Montgomery is intended for use with a multi-link chain for binding plural aligned "pipes, poles, lumber and other heavy articles on trucks, wagons and other vehicles." Montgomery does not disclose a pipe repair clamp having a slot for receiving a pipe and positioning the repair clamp about an outer circumference of the pipe. Nor does Montgomery disclose a clamp having a pair of edge flanges engaged and drawn together by the load binder until the edge flanges are drawn together by nut and bolt combinations for securing the repair clamp to the pipe in a sealed manner. The Montgomery load binder possesses none of this claimed structure, nor is it capable of interfacing with any of these claimed structures.

There are various fundamental differences between the Montgomery load binder and the claimed apparatus for installing a repair clamp on a pipe. First, the Montgomery load binder is

not disclosed for use in installing a repair clamp on a pipe, nor is it capable of performing this function. Montgomery's load binder is incapable of being removed after tightening of the chain about the bound articles with the articles remaining bound by either the chain or another non-disclosed arrangement or device. The purpose and function of Montgomery's load binder is fundamentally different from that of the claimed invention as these two devices are neither designed, nor intended, to be interchangeable. Independent claims 1 and 26 have thus been amended to recite that the arm and clasp may be disengaged and removed from the edge flanges of the repair clamp and the apparatus removed from the repair clamp following tightening of the nut and bolt combinations coupled to the clamp's edge flanges. This feature of the claimed invention is neither disclosed or even suggested in Montgomery, where removal of the load binder will result in release of the articles or objects intended to be bound together.

As disclosed on page 1, lines 84-98, of Montgomery, the adjustable feature of the load binder is incorporated in the yoke 21 in the form of a pair of spaced openings or slots 22. Extending into each of these openings 22 from one of their walls are plural spaced teeth 23. The openings 22 serve as a passage for a pair of headed studs 24 which extend outwardly from opposite sides of the shank 12 and which are adapted to engage the teeth 23. Yoke 21 is adjustably and pivotably connected to the curved shank 12 of the lever 10. Yoke 21 may be removed from the curved shank 12 and replaced by springing the sides of the yoke outwardly from one another so as to clear the studs 24 in lateral portions of the curved shank 12. Thus, the adjustable mechanism for adjusting the load binder prior to tightening is disposed in the load binder's yoke 21 in the form of a pair of elongated slots 22 in combination with plural spaced

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teeth 23 extending into the slots. However, in the claimed invention the “adjustable means” is disposed in the central body portion 102 of the repair clamp installation tool in the form of a pair of elongated apertures 120, each having plural spaced concave recesses 120a for receiving a respective attaching lug 116 as shown in FIG. 10. The claimed “adjustable means” is thus incorporated in a different component and operates in a different manner from that in the adjustable yoke arrangement of Montgomery.

The Examiner relies upon the ‘128 patent to Montgomery as an anticipatory reference with respect to the claimed invention. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of the claimed invention. *RCA Corp. v. Applied Digital Data Systems, Inc. et al.*, 730 F.2d 1440, 1444; 221 USPQ 385, 388 (Fed. Cir. 1984). However, the relevant statutory standard for determining anticipation as set forth under §102 is a high standard, for the prior art reference must teach the very invention of the patent and disclose each and every material element of the claim in question. Unless all of the same elements are found in exactly the same situation and united in the same way to perform an identical function in a single prior art reference, there is no anticipation. *General Battery Corp. v. Gould Inc.* 545 F. Supp. 731, 744; 215 USPQ 1007, 1014-1017 (D. Del. 1982). In the present case, the ‘128 patent does not disclose the an adjustable arrangement for apparatus used in installing a repair clamp on a pipe, where the adjustable arrangement is disposed on the main portion, or the body, of the apparatus, as in the claimed invention. In Montgomery, the adjustable arrangement is disposed on an end link, or yoke, connected to the load binder’s center body portion. It is respectfully submitted that the

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elongated, linear slot 22 could not be incorporated in Montgomery's body portion, or lever 10, and provide adjustability for the load binder because of the curved shape of the shank 12 at the inner end of the load binder's lever. In Applicant's invention, the elongated slot which affords adjustability of the pipe repair clamp installation tool is incorporated in the tool's body portion and could not be incorporated in the pivot arm 164 because of thin profile of the pivot arm. Moreover, there is nothing in Montgomery that suggests that the load binder disclosed therein could be used to maintain a clamp-like member in position on a pipe prior to tightening of the clamp-like member on the pipe and then be removed after the clamp-like member is tightened leaving only the clamp-like member on the pipe, as now claimed. It is respectfully submitted that the load binder of Montgomery could not be used to maintain the chain in position on the restrained articles and could then be removed following tightening of the chain allowing the chain to remain on the restrained articles in tight engagement with the articles as now recited in the pending claims for the pipe repair clamp installation apparatus. Montgomery does not disclose an arrangement for maintaining the chain on the restrained articles following removal of the load binder.

Applicant's adjustable pipe repair clamp installation tool is designed for use in confined areas as frequently a leaking pipe is buried in the ground or otherwise not readily accessible. For this reason, Applicant's invention employs only three pivotally coupled members, i.e., a body portion, an arm and a clasp. The claimed adjustable means is disposed in the device's body portion. The Montgomery load binder, on the other hand, includes additional components not found in Applicant's invention. These additional components include a pair of eye bolts 16 and

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28, a pair of links 19 and 31, and a pair of end hooks 18 and 35. These additional components increase the length of Montgomery's load binder and render it impractical for use in confined spaces. In addition, the shape of the curved link 15 in the Montgomery load binder renders it impractical for use with a pipe repair clamp. As shown in FIGS. 1, 2 and 3 in Montgomery, movement of the handle 11 of the load binder from the loose position shown in FIG. 2 to the tightened position of FIG. 3 causes the curved link 15 to be displaced inwardly toward the confined load. Movement of one of the pivoting members in Applicant's invention inwardly toward the pipe repair clamp would be prevented by contact with the pipe or the pipe repair clamp. Thus, inward displacement of one of the pivoting members during tightening of the pipe repair clamp would be prevented by contact with the pipe or the pipe repair clamp in Applicant's invention, while inward movement of one of the pivoting members in the Montgomery load binder is possible because it is used with a flexible chain for restraining an initially loose load of pipes or poles. In addition, the Montgomery load binder could not be removed from a pipe repair clamp after tightening because loosening of the load binder would require inward displacement of the binder's curved link 15 which would engage the pipe or the pipe repair clamp and prevent loosening of the load binder.

There is one additional fundamental difference between the Montgomery load binder and Applicant's pipe repair clamp installation apparatus. The adjustable mechanism in the Montgomery load binder is not intended, nor does it function, to accommodate pipes or poles of various diameters. Rather, the adjustable mechanism in the Montgomery load binder is used simply in the tightening of the load binder by adjusting the tightness of the binder about a load

prior to moving the load binder to the secure, fully tightened position. See page 1, lines 6-18.

Adjustment of the load binder and chain combination to accommodate pipes of different diameter is accomplished in Montgomery by attaching the hooks of the load binder to the appropriate links in the binding chain and not by means of the tension adjustment mechanism of the load binder. Applicant's invention, on the other hand, is designed to operate with a wide range of pipe clamp sizes and pipe diameters by means of the claimed "adjustable mechanism" or "moveable member". This feature of Applicant's invention is emphasized throughout the specification.

The Examiner argues that the recited repair clamp is not part of the claimed invention. However, pending independent claims 1 and 26 recite that the arm of the apparatus includes an end adapted for insertion in an aperture in an edge flange of a repair clamp and the clasp of the apparatus includes an end adapted to engage an outer edge of an edge flange of a repair clamp. Neither of these limitations is disclosed in Montgomery's load binder. Moreover, the adjustable means is described as allowing for changing the spacing between the arm and clasp of the apparatus to accommodate a range of repair clamp sizes and pipe diameters. This limitation is also not disclosed in Montgomery because Montgomery does not adjust for changes in pipe diameters by changing the spacing between its curved link 15 and its yoke 21, but rather by changing the length of the chain wrapped around the pipes. Thus, Applicant's invention is clearly claimed in terms of use with a repair clamp for a pipe, and is limited to structure useful in this environment. The relevant prior art does not include all restraining or clamping devices, but only those suitable for use with a repair clamp disposed on a pipe. In a case involving a driver

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adapted to set a joint with a particular threaded lobed collar, the Federal Circuit reversed a Board of Appeals rejection of the claims stating that "The framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims themselves are so limited." In re *Stencel*, 828 F.2d 751, 754; 4USPQ2d 1071, 1072 (Fed. Cir. 1987).

With this amendment, all of the pending claims are believed to define patentable subject matter. Therefore, reconsideration and allowance of the pending claims is respectfully solicited.

Respectfully submitted,

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Thomas E. Hill

Thomas E. Hill, Reg. No. 28,955
Attorney for Applicant
EMRICH & DITHMAR LLC
125 S. Wacker Drive, Suite 2080
Chicago, IL 60606-4401
Tel: 312-663-9800
Fax: 312-633-9822
Email: emrichtom@aol.com